# REMARKS

In summary, 62 claims numbered 1-20, 23-35, and 37-65 are pending. Claims 1, 12, 26, 40, 46, and 60 are independent. Claim 12 is hereby amended without adding new matter. Claims 1-20 and 23-25 are rejected under 35 U.S.C. § 103. Claims 40, 41, 43-45, 60, 61, and 63-65 are rejected under 35 U.S.C. § 102. Claims 26-35, 37-39, 42, 46-59, and 62 are rejected under 35 U.S.C. § 103. Applicants respectfully traverse all rejections. Reconsideration in view of the foregoing amendments and following remarks is respectfully requested.

## *Telephone Conversation With Examiner*

Examiner Wang is thanked for the telephone conversations conducted on October 9, 2008 and October 22, 2008. During the conversation conducted on October 9, 2008, cited art was discussed. The teaching away against combining the cited art was discussed. Differences between the cited art and the claims were discussed. Examiner Wang stated that he would consider Applicants' remarks and call Applicants' representative to discuss further. After the conversation conducted on October 9, 2008, Examiner Wang informed Applicants' representative that he found additional art and suggested another telephone conversation to discuss same. During the second conversation conducted on October 22, 2008, it was agreed that Applicants' representative would submit the instant response and receive a non-final office action based on the new art found by Examiner Wang. Again, Applicants' representative thanks Examiner Wang for his cooperation in this matter.

## *Previous Remarks*

The Office Action withdrew previous rejections, but asserts new grounds of rejection. Even so, the Examiner made the Office Action final. While the Office Action alleges that Applicants' previous remarks are moot in view of the new grounds of rejection, Applicants point out that their previous remarks are not moot because the Office Action rejects 35 of the 62 claims based in part on combinations involving the Roxburgh reference. Applicants' previous remarks pointed out that

Roxburgh teaches away from the claimed subject matter, which means that it cannot be combined with other references to try to overcome the teaching away. Specifically, Applicants said:

Roxburgh teaches away from the claimed subject matter . . . Roxburgh, § "Debugging Components in Schedules" at p. 16 ("schedules themselves can't be loaded into a visual environment and debugged."); Roxburgh, § "Debugging Schedules" at p. 14 ("Microsoft BizTalk Server does not provide a graphical debugging facility for orchestration schedules. However, remember that orchestration schedules represent a different kind of executable process from traditional short-lived synchronous processes, so the traditional debugging model alone is not effective. . . . When the orchestration schedule is compiled and then executed, typically multiple instances of the schedule will be initiated as individual (long-running) executable processes.").

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553 (Fed. Cir., 1994).

Clearly, since Microsoft personnel such as Roxburgh thought it was not possible, a person of ordinary skill would be discouraged from the claimed subject matter. This disclosure in Roxburgh teaching away from the claimed invention cannot be ignored because each "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02 VI. "It is improper to combine references where the references teach away from their combination." M.P.E.P. § 2145 X.D.2.

Therefore, Applicants respectfully submit that their prior remarks are not moot in view of the new grounds of rejection and should have been considered by the Examiner.

### _Rejection of Claims 1-20 and 23-25 under 35 U.S.C. § 103(a)_

Claims 1-20 and 23-25, including independent claims 1 and 12, are rejected under 35 U.S.C. § 103(a) as being unpatentable over (1) "BizTalk Orchestration: Transactions, Exceptions, and

Debugging," Feb. 2001, authored by Roxburgh (hereinafter referred to as "Roxburgh") in combination with either or both: (2) U.S. Patent No. 7,051,316, issued to Charisius et al. (hereinafter referred to as "Charisius"); and (3) "BizTalk Unleashed," 1st ed., Feb. 2002, authored by Adams *et al.* (hereinafter referred to as "Adams"). (Office Action, pp. 3-18). Applicants respectfully traverse the rejections.

The citations made to the references in the Office Action either do not disclose what the Office Action says they do or they actually teach away from the claimed subject matter.

First, in Charisius, the Office Action points to passages with keywords. However, the substance of those passages does not teach or suggest the claimed subject matter, e.g., "displaying a symbolic representation of the operation of the business process service based on the stored state information [e.g. runtime data]; and . . . remotely debugging the business process service using the symbolic representation . . . and stored state information." Claim 1.

In response to this subject matter in claim 1, the Office Action cites column 28, line 48 to column 29, line 3 for the word "symbol" then skips to Figure 24 and column 26, lines 59-64 for the words "state" and "events" then skips to Figure 61 for the word "debug" and then column 38, lines 8-10 for the word "remote." Keywords or not, the substance of these citations does not teach or suggest the substance of claim 1.

Looking at Figure 24 and the cited paragraph in column 28, it is very clear that it is not "a symbolic representation of the operation of the business process service based on the stored state information [e.g. runtime data]." To begin with, there are no symbols representing operations/steps carried out by the process, i.e., "a symbolic representation of the operation of the . . . process." The so-called "graphical representation of the source code" is a textual list. The so-called "symbols" only indicate the method types that the textual list falls under. There is no "symbolic representation of the operation of [a] business process." The meaning of the terms used in Charisius is not the same as claimed.

Furthermore, the so-called graphical representation and symbols, even if they were a "symbolic representation of the operation of [a] business process," are not based on stored state information. Charisius does not even contemplate that. Nonetheless, the Office Action tries to make up for that lack of disclosure by citing to a mere mention that the textual list can include a state management callback method used to tell an EntityBean "when certain events are to occur." This statement about what a listed method can do does not magically translate Figure 24 into a symbolic representation of a process based on stored state information (e.g. actual runtime data). Charisius' displayed information does not even include stored state information, let alone show a symbolic representation constructed from such information. The citations are empty, cited only for their mention of keywords. A proper rejection must be based on actual disclosure of substance, not a mere cobbling together of keywords such as "state" here, "symbol" there.

Since there is no symbolic representation of a process based on stored state information, there is also no remote debugging that relies on a symbolic representation of process operation and stored state information. Figures 60 and 61 show the debugging user interface and it does not include a symbolic representation of process operation, let alone one based on stored state information (e.g. runtime data). It is observed that the Office Action does not offer any citation as allegedly disclosing "remotely debugging the business process service using the symbolic representation . . . and stored state information." An alleged partial disclosure by Charisius is obviously not enough to even make a prima facie rejection. And this is just the end of the first point proving the rejection to be without merit.

Second, as pointed out in previous remarks, Roxburgh teaches away from the claimed subject matter of claims 1-7 and 9-11. See, e.g., Roxburgh, § "Debugging Components in Schedules" at p. 16 ("schedules themselves can't be loaded into a visual environment and debugged."); Roxburgh, § "Debugging Schedules" at p. 14 ("Microsoft BizTalk Server does not provide a graphical debugging facility for orchestration schedules. However, remember that orchestration schedules represent a different kind of executable process from traditional short-lived synchronous processes, so the traditional debugging model alone is not effective. . . .

When the orchestration schedule is compiled and then executed, typically multiple instances of the schedule will be initiated as individual (long-running) executable processes.").

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553 (Fed. Cir., 1994).

Clearly, since Microsoft personnel such as Roxburgh thought it was not possible, a person of ordinary skill would be discouraged from the claimed subject matter. This disclosure in Roxburgh teaching away from the claimed subject matter cannot be ignored because each "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02 VI. "It is improper to combine references where the references teach away from their combination." M.P.E.P. § 2145 X.D.2.

It is improper for the Office Action to ignore the part of Roxburgh that teaches away from the claimed subject matter in favor of part of a different reference. To ignore this teaching away in Roxburgh is to fail to read Roxburgh as a whole and to use improper hindsight of the claimed subject matter.

For at least the foregoing two reasons, the rejection of claim 1 is without merit. The foregoing remarks apply equally well to each of claims 1-20 and 23-25. Accordingly, Applicants respectfully request withdrawal of the rejection.

### *Rejection of Claims 40, 41, 43-45, 60, 61 and 63-65 under 35 U.S.C. § 102(b)*

Claims 40, 41, 43-45, 60, 61 and 63-65, including independent claims 40 and 60, are rejected under 35 U.S.C. § 102(e) as being anticipated by Charisius. (Office Action, pp. 18-23). Applicants respectfully traverse the rejection.

The foregoing remarks apply equally well here. The Office Action makes the same citation against claim 40 that is made against claim 1. Claims 40 and 60 say, "generating a symbolic representation of the operation of the business process service according to the design information ["about the business process service"] and tracking [or "configuration"] information ["about execution of the business process service"]; and displaying . . . a graphical debugging environment showing the symbolic representation."

The Office Action cites the same portions of Charisius cited against claim 1, i.e., column 28, line 46 to column 29, line 3; Figure 24 and column 26, lines 59-64 of Charisius. As previously pointed out, these citations fall far short. Nowhere does Charisius disclose a symbolic representation of the operation of a process, let alone a symbolic representation constructed from both design and execution information. The citations are obviously based on keywords alone and do not remotely convey the substance of the claimed subject matter. Therefore, the citations and the arguments they are made for are without merit.

Independent claims 40 and 60, as well as the claims that depend on them are clearly patentable over Charisius. Accordingly, Applicants respectfully request withdrawal of the rejection.

### *Rejection of Claims 26-35, 37-39, 42, 46-59, and 62 under 35 U.S.C. § 103(a)*

Claims 26-35, 37-39, 42, 46-59 and 62, including independent claims 26 and 46, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Adams and, in the case of claims 27-35 and 37-39, Roxburgh. Applicants respectfully traverse the rejection.

The foregoing remarks apply equally well here. The Office Action makes the same citation against claims 26 and 46 that is made against claims 1, 12, 40 and 60. Claims 26 and 46 say, "generating . . . a symbolic representation of the business process service based on a correlation of information about the design and execution of the business process service"

The Office Action cites the same portions of Charisius cited against claims 1, 12, 40 and 60, i.e., column 28, line 46 to column 29, line 3; Figure 24 and column 26, lines 59-64 of Charisius. As previously pointed out, these citations fall far short. Nowhere does Charisius disclose a symbolic representation of the operation of a process, let alone a symbolic representation constructed from both design and execution information. The citations are obviously based on keywords alone and do not remotely convey the substance of the claimed subject matter. Therefore, the citations and the arguments they are made for are without merit.

Independent claims 26 and 46, as well as the claims that depend on them, are clearly patentable over Charisius combined with Adams and Roxburgh, which do not make up for the lack of disclosure by Charisius. As such, Applicants respectfully request withdrawal of the rejection.

Amendments made herein as well as amendments previously made are without abandonment of subject matter. Applicant expressly reserves the right to, in the pending application or any application related thereto, reintroduce any subject matter removed from the scope of claims by any amendment and introduce any subject matter not present in current or previous claims.

## CONCLUSION

In view of the foregoing remarks and amendments, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are requested. Applicants desire to hold a telephone interview with the Examiner and his supervisor following their review of this reply.


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